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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,457	03/17/2000	Mukesh Dalal	020431.0671	4373

7590 03/15/2002
Baker Botts LLP
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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/528,457

Applicant(s)
Dalal

Examiner
Steven McAllister

Art Unit
2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 17-26, 31-42, and 47 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 17-26, 31 and 32 recite a method for generating a multi-variate global optimization problem and subsequently computing a solution for the problem. The method must product a “useful, concrete, and tangible result”. However, the claims merely manipulate abstract ideas without producing a “useful, concrete and tangible result”. It is not concrete since a plurality of solutions typically exist, so the result is not ensured. Depending upon the logic used in solving different solutions could be presented. Additionally, the subject matter is not tangible, since the data, global problem and solutions are all disembodied data structures residing solely in the computers.

With respect to claims 33-42 and 47, while a data structure which satisfies the requirements of 35 USC 101 in combination with readable storage medium is statutory subject matter. The software accomplishing the steps of the claims 17-26, 31 and 32 is not statutory subject matter even in combination with a tangible storage medium since the software produces no useful, concrete or tangible result.

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Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16, 26 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-16 are indefinite because they claim a “broker”. However, as is commonly used and as it is used in the specification, a broker is a person and not an apparatus. In examining the claims, it was assumed to claim “a brokerage system”.

Claims 10, 26, and 42 recite additional first and second values, then recites a global solution “satisfying the first and second values”, however there are two sets of first and second values. In examining the claim, it was assumed to satisfy the “additional” set of first and second values.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-10, 15-26, and 31-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Thiessen (5,495,412).

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Theissen shows accessing first and second optimization problems and threshold values from first and second parties, respectively, and generating at least one global optimization problem (see abstract and Fig. 1).

As to claim 19, Thiessen shows constraints relating to global variables.

As to claim 21, Thiessen shows using linear programming to generate the global problem (abstract).

As to claim 22, Thiessen shows generating a global solution satisfying the two values (abstract).

As to claim 23, Thiessen shows that the global solution is generated as a Pareto-optimal solution (col. 6, line 57).

As to claims 24 and 25, Thiessen shows that the global solution is generated using the fairness criteria of equal distribution (col. 10, lines 23-26).

As to claim 26, Thiessen discloses iteratively accessing additional first and second values and generating an additional global solution.

As to claim 31, Thiessen discloses mediating the negotiation substantially simultaneously with the negotiation between the parties.

As to claim 32, Thiessen discloses implementing the method on one or more computers.

As to claims 1-10, 15 and 16, Thiessen discloses the brokerage system for accomplishing the steps of the method of claims 17-26, 31 and 32.

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As to claims 33-42, and 47, Thiessen inherently discloses software to accomplish the steps of the method of claims 17-26, 31 and 32 since it is disclosed that the method is accomplished via a plurality of computers and it is necessary for the computers to use such software to accomplish the method.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-14, 27-30, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thiessen.

Thiessen discloses communicating possible alternative solutions to the parties, and receiving and applying filtering information comprising a weighted preferences approach from the parties. Thiessen does not disclose accomplishing these steps after the computation of the global solution. However, it would have been an obvious matter of design choice to modify the method of Thiessen by accomplishing the filtering steps after the global solution had been computed since the applicant does not state that accomplishing the filtering in this manner at this time is for any particular reason or solves a particular problem and it appears that the method would work equally well in either configuration.

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As to claims 13, 14, 29, 30, 45, and 46, Thiessen discloses communicating solutions to the parties and receiving selection information. It does not disclose choosing the solution via an auction approach. However, it is notoriously old and well known to use an auction to decide the owner of a particular right (in this case the right to choose the final solution). It would have been obvious to one of ordinary skill in the art to modify the method of Thiessen by auctioning the right to select from the acceptable, optimized solutions in order to efficiently assign that right by providing it to the party that values it most highly.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hurd, II (6,222,535) shows a computerized method for tracking issues.

Odom et al (6,058,379) show a computer based system including negotiating.

Conklin et al (6,338,050) show a computerized system with negotiating.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052.



Steven B. McAllister

March 11, 2002